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Huang patent (U.S. 6,050,810). Finally, regarding the double patenting rejection, the Applicant refers to the previous terminal disclaimer filed on April 29, 2002.

I. RESPONSE TO 35 U.S.C. § 102(b) REJECTION:

The Examiner has rejected claims 16 and 17 under 35 U.S.C. § 102(b) as being anticipated by *Tasi* (U.S. 5,531,592). The Examiner has concluded that *Tasi* discloses, "a fuel-release valve urged into a closed position, a spring mechanism having a non-operational position, an operational position, a first portion (top end of 34), and a second portion (bottom end of 34), wherein the first portion locks the trigger when the spring mechanism is in the non-operational position, and the second portion opens the fuel-release valve when the spring mechanism is in the operational position, and a safety button (36) moving the spring mechanism from the non-operational position to the operational position."

A. *Tasi* Does Not Teach Every Element of Claims 16-17.

In response, the Applicant respectfully traverses the Examiner's § 102(b) rejection based on *Tasi* because the *Tasi* reference fails to teach every aspect of the Applicant's claimed invention. MPEP § 706.02(a) instructs, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature

not directly taught must be inherently present." MPEP §706.02(a).

Tasi does not teach either explicitly or impliedly a lighter with a fuel-release valve that will close after ignition. That is, in *Tasi*, once the safety slide switch (36) is slid downwards and the firing button (22) depressed, the torch as disclosed in *Tasi* will stay lit, even when the safety slide switch is released. Once the firing button (22) moves past the depressed safety slide switch (36), the firing button (22) actually prevents the safety slide switch (36) from moving upwards. Therefore, gas continues to be expelled so long as the firing button(22) is depressed, and a flame will continue to burn so long as the firing button alone is depressed. Applicant's invention is a further step in safety, for it only allows a flame to continuously burn when the safety slide switch/safety button is continuously depressed. Then, the trigger/firing button must be depressed and the slide switch/safety button continuously depressed to release the gas. If the slide switch/safety button in Applicant's invention is released, the fuel valve is closed and the flame extinguished.

Specifically, claim 16 (lines 9-19) states, "a fuel-release valve being spring loaded so as to be urged into the closed position, a spring mechanism having a non-operational position, an operational position, a first portion and a second portion,

the first portion locks the trigger when the spring mechanism is in the non-operational position, the second portion opens the fuel-release valve when the spring mechanism is in the operational position, the spring mechanism being urged into the non-operational position, and a safety button for moving the spring mechanism from the non-operational position to the operational position." Similarly, claim 17 (lines 9-20) states, "a fuel-release valve being spring-loaded so as to be urged into the closed position, a spring mechanism having a non-operational position, an operational position, a first portion and a second portion, said first portion locks said trigger by interfering with said stopper tab when said mechanism is in the non-operational position said second portion opens said fuel-release valve when said spring mechanism is in said operational position, said spring mechanism being biased into said non-operational position, and a safety button for moving said spring mechanism from said non-operational position to said operational position…." In other words, both claims 16 and 17 state that the fuel release valve will be closed when the safety button is not depressed. In addition, depression of the safety button is required to unlock the trigger. And, of utmost importance, once the trigger has been unlocked, the safety button must continue to be depressed in order to release gas. *Tasi*'s disclosure does not teach this last critical step. A step that is a dramatic

increase in safety, for it is a feat that any child would have a hard time maintaining. Compare this to *Tasi*, whereby a child may be able to inadvertently slide the safety switch and then push the firing button at the same time. Then if the child is able to maintain pressure on only the firing button, the flame would continue.

B. *Tasi*'s Upright Pressure Rod Does Not Correlate to a Spring Mechanism.

The Examiner's §102(b) rejection based on *Tasi*, is additionally traversed as *Tasi*'s upright pressure rod (34) does not correlate with the Applicant's spring mechanism with a first and second portion. The term, upright pressure rod (34) does not teach or suggest a spring. *Tasi* does disclose a coil spring (35), which is mounted around the upright pressure rod (34). (*Tasi*, Col. 2, lines 23-25; Fig. 1 and 2). However, this coil spring (35) is a completely separate structure from the upright pressure rod (34). In contrast, the Applicant's spring mechanism, as described in claims 16 and 17 and shown in Fig. 1, shows a first portion and a second portion of a single structure that is also flexible without a separate spring. Although Examiner has asserted that Applicant's specification does not disclose a spring mechanism as a single structure, the specification and drawings when read as a whole disclose that the spring mechanism is in fact a single structure. In fact,

this single structure is one of the advantages of Applicant's invention as production of it will be more economical.

Tasi's pressure rod (34) is not a spring and has no inherent flexibility. This rod is inflexible in order to translate the motion of the slide switch (36) to move the rod out of way of the depressible firing button (22) and to contact the push button of the cigarette lighter to release fuel. (*Tasi*, Col. 2 and 3). Because of this distinct structure, *Tasi*'s upright pressure rod (34) cannot be analogous to the Applicant's first and second portions of the spring mechanism.

C. The Applicant's Claimed Invention Is Ergonomically Different and Advantageous Over *Tasi*.

Finally, Examiner's 102(b) rejection based on *Tasi* is traversed because the invention as described in Applicant's claims 16 and 17 is structurally and significantly different on its face than what *Tasi* discloses. Both the Applicant and *Tasi* present child-resistant utility lighters. However, there are significant differences in structure and components that lead to great ergonomic differences between the Applicant and *Tasi*. The purpose of the *Tasi* invention is to retrofit an existing non-child resistant lighter to make it child-resistant. Whereas the purpose of the Applicant's invention is to design a lighter itself that is child-resistant without the need for retrofitting.

To attempt to retrofit a non-child-resistant lighter to be child-resistant, *Tasi* places an adapter on a non-child-resistant lighter. However, this retrofit makes *Tasi*'s lighter inherently less ergonomically efficient as compared to the Applicant's child-resistant utility lighter. As shown in Fig. 3 of *Tasi*, the user would have to grip the holder (1) with his or her hand such that a finger, such as the index finger, could push down the slide switch (36) and simultaneously push the depressible firing button (22) or trigger with his or her thumb. By having to reach around the lighter holder (1) with a finger and at the same time to operate the trigger, *Tasi*'s lighter is more difficult to use and to operate than the Applicant's claimed lighter invention (claims 16-19).

In contrast, the Applicant's claimed invention (claims 16-19) presents a lighter that is easy to use and ergonomically efficient. As shown in Applicant's Fig. 1, the user simply depresses the safety button, which moves the fuel release lever forward along a first axis and also allows the trigger to be pushed along a second axis to activate the piezo unit to generate a spark. This can be easily accomplished with one hand and with the thumb on the safety button and the index and/or third fingers on the trigger. The Applicant's claimed invention fits easily in the user's hand and does not require any contortions or awkward movements to operate.

Also, this action of moving the fuel release lever and the trigger along parallel axes is very different from *Tasi*'s invention, which has the trigger and fuel release lever acting at substantially perpendicular axes. For these basic ergonomic reasons, which are in addition to the arguments concerning the specific claim language that distinguishes over *Tasi* presented above, the Applicant respectfully traverses the §102(b) rejection because the two inventions are fundamentally different, serve fundamentally different purposes, and achieve substantially different ergonomic results.

II. RESPONSE TO 35 U.S.C. § 102(e) REJECTION:

The Examiner has rejected claims 18 and 19 under 35 U.S.C. 102(e) as being anticipated by *Huang*. An interference is respectfully requested to determine this issue. For a 102(e) rejection, a patent may act as prior art as of the date it was filed in the United States. *Huang*'s patent issued April 18, 2000 and was filed on March 22, 1999. Applicant's application claims priority to the non-provisional U.S. Patent Application Serial No. 09/507,100, filed 02/17/2000, which in turn claims priority to a provisional U.S. Patent Application Serial No. 60/126,326, filed March 26, 1999. The effective filing dates of the *Huang* patent and Applicant's provisional application are within the statutory three months of each other. 37 C.F.R. §1.608(a). Furthermore, Applicant's invention was conceived and

reduced to practice in the United States before the filing date of the *Huang* patent. *Huang*, who is a Taiwanese citizen, and who invented in Taiwan, does not have any right to claim a date earlier than that of his United States filing date. 35 U.S.C. §104.

An interference is proper when the prospective parties to the interference are claiming "the same patentable invention." 37 C.F.R. §1.603. The "same patentable invention" may be defined as using an anticipation/obviousness standard. 37 C.F.R. 1.601(n). In this instance, the *Huang* invention and Applicant's invention anticipate each other and are obvious in light of one another. The Examiner did not contradict Applicant's assertion that claims 18 and 19 comply with 35 U.S.C. 135(b) and 37 C.F.R. 1.607(a)(6). Therefore, claims 18 and 19 are not materially different from original claims 16 and 17 and correspond to the count. In addition, the Examiner has stated that claims 18 and 19 are anticipated by *Huang*. Accordingly, since claims 18 and 19 meet the anticipation standard elucidated by 37 C.F.R. 1.601(n), an interference must be initiated upon these claims.

III. RESPONSE TO 35 U.S.C. § 103 REJECTION:

The Examiner rejected Claims 18 under U.S.C. § 103(a) as being unpatentable over *Tasi* in view of *Bruhn*. According to the Examiner, in view of *Bruhn*, it would have been obvious to one of

ordinary skill in the art at the time of Applicant's invention to modify the lighter of *Tasi* to incorporate the trigger and valve arrangement for parallel movement as taught by *Bruhn*.

Applicant believes that this invention as presently claimed falls outside of the subject matter indicated, taught, or suggested by *Tasi* in view of *Bruhn*. According to MPEP § 706.02(j), "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d. 1438 (Fed.Cir. 1991).

In response, the Applicant respectfully traverses this rejection based on § 103(a) because neither the references nor the knowledge available to those skilled in the art suggest combining the references. In addition, neither the prior art references, nor their combination, teaches or suggests all the claim limitations.

A. NO SUGGESTION EXISTS IN THE REFERENCES NOR KNOWLEDGE AVAILABLE TO THOSE SKILLED IN THE ART THAT SUGGESTS COMBINING *TASI* AND *BRUHN*.

Examiner's 103(a) rejection is respectfully traversed because there is no suggestion in the references nor knowledge available to those skilled in the art that suggests combining the references. The United States Court of Customs and Patent Appeals teaches that "... a reference ... is only good for what it clearly and definitely discloses." *In re Moreton*, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961). Furthermore, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the Applicant's claims. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.") In this instance, there is no teaching or suggestion in either the *Tasi* or *Bruhn* references relied on by the Examiner that suggests combining the two references. Therefore, unless there is knowledge available to one of ordinary skill in the art suggesting such a combination, the *Tasi* and *Bruhn* references may not be combined to form an obviousness rejection.

The U.S. Court of Customs and Patent Appeals teaches, "[w]hether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art." *In re Free*, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964). Therefore, either the *Tasi* reference or the *Bruhn* reference must reasonably and realistically teach or suggest to those of ordinary skill that the two references should be combined with each other. A review of these two references shows that such a teaching or suggestion cannot be found.

The *Tasi* invention specifically relates to a device that incorporates commercially available cigarette lighters and transforms the cigarette lighter into a child-resistant gas torch. For the *Tasi* invention to create a flame, a cigarette lighter must be placed inside the *Tasi* device. Therefore, the *Tasi* device discloses a method of transforming an existing lighter into a child-resistant torch.

On the other hand, *Bruhn* disclosure serves an entirely different purpose. It has nothing to do with transforming an existing lighter. Rather, *Bruhn* discloses a self-contained utility lighter. As *Bruhn*'s disclosure does not require incorporation of another lighter in order to generate a flame, *Bruhn*'s invention is complete in and of itself. No outside source is necessary to create the flame. Accordingly, the *Tasi*

and *Bruhn* devices are used for different purposes, and there is no reasonable nor realistic teaching or suggestion to those of ordinary skill that *Tasi* should be combined with *Bruhn*.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an Applicant's claims are obvious. The law does not sanction such a piecemeal construction of the prior art. *In re Kamm & Yo,* 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972)("a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure shall not be the basis for a holding of obviousness.") *See also,* In re Newell, 891 F.2d 899, 901 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) ([a] retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination.") As hindsight reconstruction is not proper, these references cannot be combined in order to form a 103(a) rejection.

B. APPLICANT'S CLAIMS GO BEYOND ANY REASONABLE COMBINATION OF *TASI* IN VIEW OF *BRUHN*.

Even if the Examiner finds that there is some suggestion to those of ordinary skill in the art to combine the two references, the references when combined must teach or suggest all the claim limitations. In this instance, Applicant's claim

18 goes beyond any reasonable combination of the prior art references. Accordingly, Examiner's 103(a) rejection is respectfully traversed.

The Examiner asserts that *Tasi* discloses all the limitations of claim 18 except that the fuel release valve is capable of movement on an axis parallel to the axis of movement of the trigger. Claim 18 differs from claim 16, only with respect to this axis upon which the fuel release valve is capable of movement. Therefore, the Examiner is essentially stating that *Tasi* discloses all of the limitations of claim 16. Applicant has already traversed in detail Examiner's assertion that claim 16 is anticipated by *Tasi*, and Applicant incorporates all of the argument of Section I above as if stated herein. Therefore, even assuming that *Bruhn* may be combined with *Tasi* to disclose that the fuel release valve is capable of movement on an axis parallel to the axis of movement of the trigger, since *Tasi* fails to disclose the other limitations of claim 18 (as discussed in Section I above), *Tasi* in combination with *Bruhn* fails to teach all of the claim 18 limitations. Consequently, as neither *Tasi* nor *Bruhn* teaches that which is in Applicant's Claim 18, either singly or taken together in any reasonable combination, Applicant believes that Claim 18 is allowable over *Tasi* in view of *Bruhn*.

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IV. RESPONSE TO ARGUMENTS REGARDING INTERFERENCE:

Examiner has stated that claims 16 and 17 are not patentable, and therefore an interference cannot be initiated. Examiner rejected claims 16 and 17 pursuant to 35 U.S.C. 102(b) as being anticipated by *Tasi*. As Applicant has traversed Examiner's 102(b) rejection, it is Applicant's position that claims 16 and 17 are patentable and that an interference must be initiated.

Examiner has also stated that an interference cannot be initiated because claims 16 - 19 are not directed to the same invention of *Huang*. Examiner has asserted that the lighter of *Huang* is both structurally and functionally distinct from Applicant's lighter. An interference is proper when the prospective parties to the interference are claiming "the same patentable invention." 37 C.F.R. §1.603. The "same patentable invention" may be defined as using an anticipation/obviousness standard. 37 C.F.R. 1.601(n). A separate patentable invention requires that the separate invention be new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103). 37 C.F.R. 1.601(n). In this instance, the *Huang* invention and Applicant's invention anticipate each other and are obvious in light of one another. In fact, with respect to claims 18 and 19, the Examiner has already asserted that these claims are anticipated by *Huang*. Accordingly, since claims 18 and 19 meet the anticipation

standard elucidated by 37 C.F.R. 1.601(n), an interference must be initiated upon these claims.

The Examiner has also stated that the trigger locking mechanism of *Huang* differs from that of Applicant. Specifically, the Examiner has stated that "the hook structure of *Huang* is critical to his claimed means of preventing trigger actuation, whereas a person of ordinary skill in the art would not be prompted to include such a hook in any portion of Applicant's trigger locking mechanism." Applicant respectfully disagrees with the Examiners analysis. The analogous structure of *Huang*'s hook is Applicant's cam-lever edge (81). Although not called a hook, Applicant's cam-lever edge performs the same function as *Huang*'s hook. In fact, *Huang*'s hook could just as easily be called an edge, or Applicant's edge could just as easily be called a hook. In both *Huang* and Applicant's disclosure, the hook or edge abuts the trigger preventing it from moving. The trigger in both disclosures can then only be moved once the safety switch acts upon the latch or cam lever, thereby moving the hook or edge from blocking the trigger.

The Examiner also states that Applicant's knob/safety button does not claim or disclose that the knob safety button engages the plug/valve. However, Applicant's claims 16 - 19 disclose that the safety button moves the spring mechanism, the spring mechanism having a second portion. Applicant's claims

further disclose that the second portion of the spring mechanism opens the fuel release valve. In other words Applicant's safety button engages the valve by moving the second portion of the spring mechanism. Therefore, Applicant's claims disclose that the safety button engages the valve.

Finally, Examiner states that Applicant's claims 16 and 18 do not claim that movement of the safety button releases the trigger locking portion. Applicant again disagrees with Examiner's reading of Applicant's claims 16 and 18. Applicant claims that the safety button moves the spring mechanism, the spring mechanism having a first portion. Applicant further claims that the first portion locks the trigger when the spring mechanism is in the nonoperational position. Therefore, in the operational position, the trigger is unlocked. Applicant believes that it has sufficiently claimed that the safety button releases the trigger locking portion in claims 16 and 18.

Based on these arguments, it is Applicant's position that *Huang*'s invention is structurally and functionally the same as that of Applicants. Accordingly, an interference must be initiated based on these claims.

V. RESPONSE TO DOUBLE PATENTING REJECTION:

The Examiner rejected claims 18 and 19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,186,773.

On April 29, 2002, Applicant filed a terminal disclaimer for the instant application with U.S. Patent No. 6,186,773. The disclaimer reads in pertinent part that "the owner hereby agrees that any patent granted on the instant application shall be enforceable... This agreement runs with any patent granted on the instant application..." Accordingly, Examiner's double patenting rejection of claims 18 and 19 are respectfully traversed.

Please note that the instant application is a continuing application of U.S. Serial No. 09/751,628, now issued as U.S. Patent No. 6,186,773 on February 13, 2001. Please note that both applications have been assigned to Calico Brands, Inc.

VI. CONCLUSION:

In light of the above arguments, the Applicant respectfully requests reconsideration of claims 16 - 19. The Applicant believes the pending claims represent allowable subject matter if the Applicant prevails in the interference. Specifically, Applicant believes that original claim 16 and 17 are allowable over *Tasi* and interfering with *Huang*, that claim 18 is not obvious in light of *Tasi* as applied to *Bruhn*, that claims 18 and 19 are substantially the same as the original claims and are allowable over *Tasi* and interfering with *Huang*, and respectfully requests that an interference be declared between this instant application and U.S. Patent No. 6,050,810 (*Huang*).

If any additional fees are required for this amendment and response, the Director is authorized to deduct the required amounts from our deposit account no. 500703.

Respectfully Submitted,

TROJAN LAW OFFICES

By

Dated: January 30, 2003

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